

REMARKS

In response to the Office Action dated May 18, 2007, the Applicants have amended claims 1, 13, 24 and 27. Claims 1-28 remain in the case. Reexamination and reconsideration of the application, as amended, are requested.

The Office Action rejected claims 1-2, 13, 24, 25 and 27-28 under 35 U.S.C. § 102(b) as being anticipated by Lee et al. (U.S. Patent Publication No. 2003/0193593). The Office Action rejected claims 3-9, 14-20 and 26 under 35 U.S.C. § 103(a) as being unpatentable over Lee et al. in view of Kinjo et al (U.S. Patent No. 6,631,208). The Office Action rejected claim 23 under 35 U.S.C. § 103(a) as being unpatentable over Kinjo et al. in view of Kinjo et al. in further view of the Examiner's Official Notice.

The Applicants respectfully traverse these rejections based on the amendments to the claims and the arguments below.

Specifically, the Applicants' newly amended claims now include accessing a first set of sampling photo-sensing pixels of the image sensor and accessing a second set of non-sampling pixels of the image sensor, wherein the first and the second set of pixels have different physical circuitry addressing and control lines going to them, respectively.

In contrast, with regard to the anticipation rejection, although the Lee et al. reference disclose X-Y addressable active pixel sensors, the Lee et al. reference is missing the Applicants' newly claimed accessing a first set of sampling photo-sensing pixels of the image sensor and accessing a second set of non-sampling pixels of the image sensor, wherein the first and the second set of pixels have different physical circuitry addressing and control lines going to them, respectively. Instead, the Lee et al. reference use serial shift registers to select image windows for the active sensors, unlike the Applicants' claimed invention. Since the Lee et al. reference is missing at least one feature of the claimed invention, the anticipation rejection should be withdrawn.

With regard to the obviousness rejection, as argued above, not only is the Lee et al. reference missing at least one feature of the Applicants' claimed invention, the combined cited references are also missing features of the claimed invention. Namely, the Kinjo reference merely disclose a digital laboratory system 10 (see FIG 1) for performing red-eye correction upon digital images, which when combined with

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the Lee et al. reference are still missing the Applicants' claimed accessing a first set of sampling photo-sensing pixels of the image sensor and accessing a second set of non-sampling pixels of the image sensor, wherein the first and the second set of pixels have different physical circuitry addressing and control lines going to them, respectively. Hence, because the combined cited references are missing at least one feature of the claimed invention, the obviousness rejections should be withdrawn.

Further, even though the combined references do not disclose, teach, or suggest the Applicants' claimed invention, the references should not be considered together because Kinjo teach away from the Applicants' claimed invention. MPEP section 2143.01, part V. clearly states that "[I]f proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). Also, MPEP section 2143.01, part VI. states that "[I]f the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959).

In particular, FIG 1 of Kinjo explicitly depicts a line CCD 30 included within a line CCD scanner 14. Line CCD 30 is conventional in nature such that if line CCD 30 were to be read (i.e., if output were to be generated by line CCD 30), then all pixels of line CCD 30 would be read/output. That is, it is impossible for less than all of the pixels of line CCD 30 to be read from (output by) line CCD 30. The output of line CCD 30 is converted from analog to digital by A/D converter 32, with the output of A/D converter 32 representing the output of line CCD scanner 14. Consequently, the function and operation of Kinjo would be destroyed if the Applicants' claimed accessing a first set of sampling photo-sensing pixels of the image sensor and accessing a second set of non-sampling pixels of the image sensor, wherein the first and the second set of pixels have different physical circuitry addressing and control lines going to them, respectively. This is because the line CCD 30 of Kinjo cannot have different physical circuitry addressing and control lines going to the pixels, and thus, Kinjo cannot read/output less than all of its pixels, unlike the Applicants' claimed invention which also uses a pixel-differentiated image sensor for which member-pixels of a subset of the entire set of pixels are individually addressable, the image sensor being controllable to read less

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than all of the pixels without having to read all of the pixels.

Therefore, the proposed modification or combination would render Kinjo being modified unsatisfactory for its intended purpose and would change the principle of operation of the invention in Kinjo being modified if Kinjo used a pixel-differentiated image sensor with pixels that are individually addressable and were to access a first set of sampling photo-sensing pixels of the image sensor and access a second set of non-sampling pixels of the image sensor, wherein the first and the second set of pixels have different physical circuitry addressing and control lines going to them, respectively, like the Applicants' claimed invention. In fact, Kinjo cannot be combined with any reference that reads individually addressable pixels because the pixels in Kinjo are clearly not intended to be individually addressable and are only for group processing purposes (see Abstract, Summary and FIG. 1 of Kinjo).

Therefore, this "teaching away" prevents the Kinjo reference from being used by the Examiner. ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). Thus, since the Applicants' claimed elements are not disclosed, taught or suggested by the combined references and because Kinjo teach away from the Applicant's invention, Kinjo cannot be used as a reference alone or in combination with other references, and hence, the Applicant submits that the rejections should be withdrawn. MPEP 2143.

Also, the Examiner is reminded that these references should not be considered together with the benefit of hindsight. It is well-settled in the law that improper hindsight occurs when knowledge and advantages from the Applicant's disclosure is used or words or phrases are arbitrarily picked and chosen from references to recreate the Applicant's invention. Crown Operations International, Ltd. v. Solutia, Inc., 289 F.3d 1367, 62 USPQ2d 1917 (Fed. Cir. 2002). In particular, the combination of elements in a manner that reconstructs the Applicant's invention only with the benefit of hindsight is insufficient to present a *prima facie* case of obviousness. Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve, Inc., 796 F.2d 443, 230 USPQ 416 (Fed. Cir. 1986).

Even if the references in question seem relatively similar "...the opportunity to judge by hindsight is particularly tempting. Hence, the tests of whether to combine references need to be applied rigorously," especially when the Examiner uses a reference that does not explicitly disclose the exact elements of the invention or teaches away from the Applicant's claimed invention, which is the case here. McGinley v. Franklin Sports Inc., 60 USPQ 2d 1001, 1008 (Fed. Cir. 2001). Since

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hindsight cannot be used to support the rejections, the combined cited references cannot render the Applicant's invention obvious and the rejection is improper and should be withdrawn. Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve, Inc. Accordingly, this failure of the cited references to disclose, suggest or provide motivation for the Applicant's claimed invention indicates a lack of a prima facie case of obviousness (MPEP 2143).

With regard to the dependent claims, because they depend from the above-argued respective independent claims, and they contain additional limitations that are patentably distinguishable over the cited references, these claims are also considered to be patentable (MPEP § 2143.03).

Thus, it is respectfully requested that all of the claims be allowed based on the amendments and arguments. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue. Additionally, in an effort to further the prosecution of the subject application, the Applicants kindly invite the Examiner to telephone the Applicants' attorney at (818) 885-1575 if the Examiner has any questions or concerns. Please note that all correspondence should continue to be directed to:

Hewlett Packard Company
Intellectual Property Administration
P.O. Box 272400
Fort Collins, CO 80527-2400

Respectfully submitted,
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Edmond A. DeFrank,
Attorney for Applicants
Reg. No. 37,814
(818) 885-1575 TEL
(818) 885-5750 FAX